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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,207	11/01/2001	Jose Fernandez	6021.026-CONT.	6367
32361	7590	09/10/2004	EXAMINER	
GREENBERG TRAURIG, LLP 885 3RD AVENUE NEW YORK, NY 10022			PRIDDY, MICHAEL B	
			ART UNIT	PAPER NUMBER
			3732	
DATE MAILED: 09/10/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/004,207

Applicant(s)

FERNANDEZ ET AL.

Examiner

Michael B Priddy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,4-12,15-23,25,32,36-40,44-49 and 52-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 45-49 and 52-63 is/are allowed.
- 6) ☒ Claim(s) 2,4-7,9,18-20,25,32,36-40 and 44 is/are rejected.
- 7) ☒ Claim(s) 8,10-12,15-17 and 21-23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2, 4, 5, 36 and 37 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 24 and 25 of U.S. Patent No. 6,319,286 in view of Luman (U.S. 5,002,578). Claims 1, 2, 24 and 25 of Patent 6,319,286 recite all of the limitations of the present invention except wherein said distal segment includes a bone engaging outer surface portion comprising longitudinal flutes and a coronal slot formed along an incremental length thereof.

Luman teaches a modular hip stem prosthesis including a stem 12 having a cylindrical shaft 18 with longitudinal flutes 22 and a coronal slot 24. The longitudinal flutes 22 secure the distal stem 18 "against rotation" (lines 11-14 of column 8) while the coronal slot 24 "provides a limited degree of resilience to the distal end of shaft 18 so that translational forces imposed thereon are more uniformly distributed to adjacent

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bone." (lines 27-30 of column 5) It would have been obvious to one of ordinary skill in the art at the time of the present invention to form longitudinal flutes and a coronal slot on the distal segment of the modular hip prosthesis of claims 1, 2, 24 and 24 of '286 since these features would secure against rotation of the distal segment and uniformly distribute forces from the distal segment to adjacent bone.

Claims 6, 19, 38 and 40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 24 and 25 of U.S. Patent No. 6,319,286 in view of Lopez et al. (U.S. 5,972,032). Claims 1, 2, 24 and 25 of Patent 6,319,286 recite all of the limitations of the present invention except said distal segment includes a bone engaging outer surface portion selected from the group consisting of a grit blasted surface, sintered metal bead coating, hydroxylapatite coating, plasma spray coating, bio-glass ceramic coating, demineralized bone and carrier, and growth factor and carrier.

Lopez et al. teaches an acetabular shell for an implantable hip prosthesis and discloses as techniques commonly used in the art to promote bone ingrowth or ongrowth grit-plating and plasma spraying. It would have been obvious to one of ordinary skill in the art at the time of the present invention to increase the surface area of the outer surface of the distal segment of the modular hip prosthesis of claims 1, 2, 24 and 25 of '286 to promote bone ingrowth or ongrowth.

Claims 2, 9, 18, 20, 25, 39 and 44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 24 and 25 of U.S. Patent No. 6,319,286 in view of Amstutz et al. (U.S. 5,156,627).

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Claims 1, 2, 24 and 25 of Patent 6,319,286 recite all of the limitations of the present invention except distal, metaphyseal and proximal segments are constructed from a material selected from the group consisting of titanium metal alloy, cobalt chromium alloy, and stainless steel.

Amstutz et al. teaches a femoral hip prosthesis which is preferably formed of titanium or a titanium alloy for compatibility and affinity with human bone growth. It would have been obvious to one of ordinary skill in the art at the time of the present invention to form the distal, metaphyseal and proximal segments of claims 1, 2, 24 and 25 of '286 of titanium or titanium alloy so that it would be biologically inert with, compatible with and have an affinity with the patient's bone.

Claims 2, 7 and 32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 24 and 25 of U.S. Patent No. 6,319,286 in view of the following. Claims 1, 2, 24 and 25 recite all of the limitations of the present invention except the transverse cross section of the distal segment being circular. It would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to construct the distal segment of the modular hip stem of claims 1, 2, 24 and 25 of '286 with a circular transverse cross section, since Applicant has not disclosed that such solves any stated problem or is anything more than one of numerous shapes or configurations a person ordinary skill in the art would find obvious for the purpose of providing distal segment for a modular hip prosthesis. In re Dailey and Eilers, 149 USPQ 47 (1966).

Allowable Subject Matter

Claims 8, 10-12, 15-17 and 21-23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 45-49 and 52-63 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael B. Priddy whose telephone number is (703) 308-8620. The examiner can normally be reached on Mon.-Fri. 8 a.m. - 5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael B. Priddy

Michael B. Priddy
September 8, 2004